RESPONSE UNDER 37 CFR § 1.111
Serial Number: 10/705,315
Filing Date: November 10, 2003
Title: DATA FLOW MANAGEMENT APPARATUS, SYSTEMS, AND METHODS (As Amended)

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REMARKS

This communication responds to the Office Action mailed on August 7, 2006. No claims are amended, no claims are canceled, and no claims are added. As a result, claims1-32 are now pending in this Application.

§102 Rejection of the Claims

Claims 1-6, 11-13, 17-23, 28, and 32 were rejected under 35 USC § 102(e) as being anticipated by Scifres et al. (U.S. 2003/0225905 A1; hereinafter "Scifres"). The Applicant does not admit that Scifres is prior art and reserves the right to swear behind this reference at a later date. In addition, because the Office has not properly established a *prima facie* case of anticipation, the Applicant respectfully traverses this rejection of the claims.

Anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.,* 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). "The *identical invention* must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Claims 1, 11, 19, and 28 each recite "a data flow associated with at least one of a selected number of ports having a first actual usage value above a determined average shared resource usage value associated with the selected number of ports sharing a resource, wherein the selected number of ports each use an amount of the resource greater than a guaranteed minimum amount of the resource". This type of operation is neither taught nor suggested by Scifres.

In its "Response to Arguments," the Office equates the "guaranteed minimum amount" claimed by the Applicant with the "volume limit 34" of Scifres. This reference notes that "said

step for defining said usage limit further comprises … calculating an average volume for the
usage devices; selecting a usage-pattern factor greater than unity; and multiplying said average
volume by said usage-pattern factor." Scifres, pg. 8, claim 2. That is, the average volume of
Scifres is always *less* than the usage limit. *See* Scifres, FIGs. 6A, 6B, and paras. [0049] and
[0050].

As a matter of contrast, the average shared resource value claimed by the Applicant is
greater than the guaranteed minimum amount. This is because, as is stated in the Applicant's
independent claims 1, 11, 19, and 28, "… the selected number of ports each use an amount of the
resource greater than a guaranteed minimum amount of the resource …". Thus, the "average
shared resource usage value" claimed by the Applicant must be greater than the claimed
"guaranteed minimum amount of the resource," and not less, as taught by Scifres.

Since Scifres does not teach the identical invention claimed by the Applicant, claims 1,
11, 19, and 28 (and all claims depending from them) should be in condition for allowance.
Reconsideration and withdrawal of the rejection under § 102 is therefore respectfully requested.

§*103 Rejection of the Claims*

Claims 7-10, 14-16, 25-27, and 30-31 were rejected under 35 USC § 103(a) as being
unpatentable over Scifries in view of Sato (U.S. 6,009,078; hereinafter "Sato") and further in
view of Ruutu et al. (U.S. 2003/0123392 A1; hereinafter "Ruutu"). Claim 24 was rejected under
35 USC § 103(a) as being unpatentable over Scifries in view of Liang (U.S. 5,933,427 A;
hereinafter "Liang"). Claim 29 was rejected under 35 USC § 103(a) as being unpatentable over
Scifries in view of Roberts (U.S. 6,104,712 A; hereinafter "Roberts"). The Applicant does not
admit that Scifres, Sato, Ruutu, Liang, or Roberts are prior art, and reserves the right to swear
behind these references in the future. And, since a *prima facie* case of obviousness has not been
established as required by M.P.E.P. § 2142, the Applicant respectfully traverses this rejection.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of
obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).
The M.P.E.P. contains explicit direction to the Examiner in accordance with the *In re Fine* court:

> In order for the Examiner to establish a *prima facie* case of obviousness, three base
> criteria must be met. First, there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of
ordinary skill in the art, to modify the reference or to combine reference teachings.
Second, there must be a reasonable expectation of success. Finally, the prior art
reference (or references when combined) must teach or suggest all the claim
limitations. The teaching or suggestion to make the claimed combination and the
reasonable expectation of success must both be found in the prior art, and not based
on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20
U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

The requirement of a suggestion or motivation to combine references in a *prima facie* case of
obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61
U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by
evidence in the record.

No proper *prima facie* case of obviousness has been established because (1) the proposed
combinations do not teach all of the limitations set forth in the claims, (2) there is no motivation
to combine the references, and (3) the proposed combinations provide no reasonable expectation
of success. Each of these points will be detailed below.

The proposed combinations will not render all claimed elements: As reiterated above,
and admitted by the Office in prior actions, Scifres "fails to teach the determined average shared
resource value as associated with the selected number of ports sharing a resource after exceeding
a guaranteed minimum amount of the resource." That is, not only does Scifres fail to describe "a
data flow associated with at least one of a selected number of ports having a first actual usage
value above a determined average shared resource usage value associated with the selected
number of ports sharing a resource, wherein the selected number of ports each use an amount of
the resource greater than a guaranteed minimum amount of the resource" as set forth above, this
reference also fails to teach what is explicitly stated in claim 25, namely, the existence of "… a
determined average shared resource usage value greater than the minimum memory resource
…". Sato, Ruutu, Liang, and Roberts fail for the same reason, and the Office makes no assertion
with respect to these references to remedy the deficiency.

There is no motivation to combine the references: The claims are also nonobvious
because the test for obviousness under § 103 must take into consideration the invention as a
whole; that is, one must consider the particular problem solved by the combination of elements
that define the invention. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227

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U.S.P.Q. 543, 551 (Fed. Cir. 1985) (emphasis added). References must be considered in their entirety, including parts that teach away from the claims. See MPEP § 2141.02.

No proper *prima facie* case of obviousness has been established because both Sato and Ruutu teach away from the combinations suggested. That is, Sato teaches minimum guaranteed values that are in fact maximum values, because cell transmission does not occur if the number of cells equals or exceeds these values. *See* Sato, Col. 5, lines 1-8.

Ruutu operates to shift free capacity as soon as a nominal capacity has been exceeded. This is simply the allocation of a resource from one channel to another as soon as the capacity of a first channel is exceeded, taking away capacity from the second channel. *See* Ruutu, paras. [0016]-[0017]. Thus Ruutu, which uses an absolute capacity to regulate switching, also teaches away from using an average capacity associated with a guaranteed minimum value of the resource, as claimed by the Applicant.

The proposed combinations provide no reasonable expectation of success: Even if the proposed combinations are made, no reasonable expectation of success arises. This is because neither Sato nor Ruutu provide flow control with respect to an average shared resource value associated with a true guaranteed minimum resource usage. Thus, one of ordinary skill in the art would not expect that combining these references would produce the claimed embodiments.

In summary, the references neither teach nor suggest the existence of "a data flow associated with at least one of a selected number of ports having a first actual usage value above a determined average shared resource usage value associated with the selected number of ports sharing a resource, wherein the selected number of ports each use an amount of the resource greater than a guaranteed minimum amount of the resource ...", or "... a determined average shared resource usage value greater than the minimum memory resource ..." as claimed by the Applicant. Thus, independent claims 1, 11, 19, 25, and 28 are nonobvious. All dependent claims are also nonobvious, since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

Further, there is no motivation to combine the references, and no reasonable expectation of success arises if the proposed combinations are made. Thus, the requirements of *M.P.E.P.* § 2142 have not been satisfied; and a *prima facie* case of obviousness has not been established

with respect to the Applicant's claims. It is therefore respectfully requested that the rejection of
claims 1-32 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and
notification to that effect is earnestly requested. The Examiner is invited to telephone the
Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary,
please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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